

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PAOLO GIACOMONI

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Appeal No. 2002-1494  
Application No. 08/894,788

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MAILED

DEC 16 2002

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

ORDER REMANDING TO THE EXAMINER

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Before STONER, Chief Administrative Patent Judge,  
HARKCOM, Vice Chief Administrative Patent Judge, and  
WILLIAM F. SMITH, Administrative Patent Judge.

***Per Curiam.***

The Office of the Deputy Commissioner for Patent Examination Policy has requested that this application be remanded to the jurisdiction of the patent examiner so that issues raised in this appeal can be reconsidered. Accordingly, we ***remand***.

***A. Findings of Fact:***

An Examiner's Answer was mailed on June 22, 2001 (Paper No. 26). Appellants filed a Reply Brief on August 21, 2001 (Paper No. 27). On September 21, 2001, the examiner responded by entering a Supplemental Examiner's Answer (Paper No. 29).

On December 1, 1997, the rule pertaining to the Examiner's Answer and Reply Brief, 37 CFR § 1.193, was amended to read as follows:

(b)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of such examiner's answer . . . . The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.


#### **B. Conclusion**

In view of the changes to 37 CFR § 1.193, the entry of the Supplemental Examiner's Answer mailed September 21, 2001 (Paper No. 29), is inappropriate.

Apprised of these problems, the Office of the Deputy Commissioner of Patent Examination Policy has requested this remand.

The Board **must** be informed promptly of any action affecting the appeal in this case, including reopening prosecution, allowance and/or abandonment of the application.

**REMAND**

  
Bruce H. Stoner, Jr., Chief  
Administrative Patent Judge

  
Gary V. Harkcom, Vice Chief  
Administrative Patent Judge

  
William F. Smith  
Administrative Patent Judge

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